

REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the claims responsive to define the invention in clearer form and to distinguish patentably from the prior art.

In considering the reference patent 5,168,965 which has been applied by the Examiner, applicant finds that this reference patent does not meet the conditions of applicant's claim 5. Thus, this reference patent does not provide two mutually dependently-controlled parallel bypasses between the two chambers. Whereas the reference patent 5,168,965 discloses two bypass channels 22, 25; 18 and 23; 24, 16; these two bypass channels are not mutually dependently controllable.

The reason for that is that the cylindrical slider 4 in the reference patent 5,168,965 can assume precisely only two positions. In each of these two positions, the slide 4 can be operative exclusively on only one single bypass channel.

If the slide 4 is in the position shown in Figure 1, then the bypass channel 23, 24, 16 is open and the other bypass channel 22, 25, 18 is closed. As a result, the closed bypass 22, 25, 18 shown in Figure 1, does not serve as a bypass channel which is mutually dependently controllable from the bypass channel 23, 24, 16.

It is apparently therefore that in the reference patent 5,168,965 there is not disclosed a bypass system which has two mutually dependently controllable bypass channels.

In view of that alone, applicant's claim 5 is novel over this reference patent 5,168,965 and distinguishes patentably therefrom.

A further important difference between the reference patent 5,168,965 and applicant's claim 5, is that applicant's claim 5 provides that a secondary piston is arranged in one of the bypasses. In the reference patent 5,166,965 the Examiner

interpreted the second piston to be element 9 in this reference patent, but this element is not within one of the bypasses. Instead, this element 9 is coupled through springs 7, 13 with the movable valves 19, 20, and functions within the bypass channels 23, 24, 16 and also within the bypass channels 22, 25, 18, dependent on which position the slide 4 assumes.

Thus, if the slide 4 assumes the position shown in Figure 1 of the preceding reference patent, then the lower bypass channel 23, 24, 16 is opened and the secondary piston interpreted by the Examiner as element 9 operates on the single bypass flow through the bypass channel 23, 24, 16. As a result, the bypass channel 22, 25, 18 is not flowed through by damping fluid because the control slide of the bypass channel 22 is separated from the bypass channel 18.

If the control slide 4 assumes the single other possible position, then the bypass channel 22, 25, 18 is opened and the bypass channel 23, 24, 16 is closed through the control slide 4. In that case, the element 9 interpreted by the Examiner to be the secondary piston, becomes operative together with the movable valve 19 within the single bypass flow which then flows through the bypass channel 22, 25, 18.

The operating bypass in the reference patent 5,168,965 in the suction stage or the bypass in the compression stage is described in this reference patent in column 2, lines 20 to 33. The sentence bridging columns 1 and 2 also describes clearly the concept of the reference patent 5,168,965. Thus, there is described that "the instant invention makes it possible to establish one characteristic for the pressure stage and another for the vacuum stage in accordance with the particular situation."

Consequently, in the reference patent 5,168,965 it is evident that at each instant of time only a single bypass channel is applicable, whereas in applicant's invention there are at last two bypass channels which function or operate

simultaneously and are dependently controllable with respect to each other.

In view of the preceding differences applicant's invention as defined in claim 5 is not only novel over the reference patent 5,168,965, but this claim is based on inventive considerations which a person working in the field cannot derive from the reference patent 5,168,965.

Thus, a person working in the art could not arrive at the concept of two hydraulic parallel and mutually dependently controllable bypass to bypass channels which at each instant of time cooperate together and have a flow resistance which is influenced by the control slide 14, so that these bypass channels are dependent on each other.

Furthermore, the reference patent 5,168,965 does not anticipate or disclose any hint from which a person working in the art could arrive at the concept of providing a secondary piston within one of the at least two parallel bypass channels, so that this second piston can be operative only within one of these bypass channels. Even if one were to interpret the element 9 in the reference patent to be the secondary piston in the sense of applicant's invention, then this element is not operable within one of a plurality of bypass channels. Accordingly, also for this reason a person working in the art cannot arrive at the concept of applicant's invention which is defined in applicant's claim 5.

In the Office Action on page 2, point 4, the Examiner asserts that the control slide 4 in the reference patent 5,168,965 can open or close more or less the bypass system. However, this assertion is incorrect, as seen by the abstract of this reference patent which describes the control slide 4 to assume only two positions, whereby in each of these positions only a single bypass channel can be opened whereas the other channel is closed.

Accordingly, in the preceding reference patent, there is provided an arrangement in which only a single bypass channel is operative in the suction stage and a bypass channel is operable in the compression stage.

In applicant's invention, on the other hand, the cross-sections of the two mutually dependably controllable bypass channels are continuously varied with the aid of the control breaches 16, 19 in the control slide 4, and thereby the flow resistance of the bypass channels is continuously varied.

As a result, applicant's invention has an entirely different functional concept than what is described in the reference patent 5,168,965.

The differences described above between applicant's invention and the reference patent 5,168,965 are applicable also to the Examiner's assertions in point 7 on page 2 of the Office Action. In view of these differences, a person working in the art can also not arrive at applicant's invention as defined in claim 5 when having before him the reference patent 6,460,663 in combination with patent 5,168,965. Applicant's invention would also not be obvious to a person skilled in the art when having before him these two references to consider and to combine.

Also in the reference patent 6,460,663 there is not disclosed any bypass system in which two mutually dependably controllable bypass channels are provided. The bypass channels 27, 28 according to the reference patent 6,460,663 are not dependably controllable with respect to each other. Instead, the channels can only be controlled after one another.

In the single figure of the reference patent 6,460,663 there is disclosed a position of the controlled slide 13 through which the two bypass channels 27 and 28 are closed. If the control slide is somewhat lifted, then the bypass channel 27 is partially free, so that this channel can function hydraulically. The bypass channel 28 remains, on the other hand, still always closed.

When the control slide 13 in the reference patent, 6,460,663 is lifted with its control edge so that the bypass channel 28 is at least partially free, then the control slide 13 is in a position in which the bypass channel 27 is no longer influenced.

As a result, it is not possible with the arrangement disclosed in the reference patent 6,460,663 to control the bypass channels 27 and 28 mutually dependable and simultaneously.

Accordingly, even when a person working in the art will combine the reference patents 5,168,965 and 6,460,663 he will not arrive at applicant's invention as defined in applicant's claim 5.

It is submitted that applicant provides for a new and marked improvement over the prior art.

Since the base claim 5, defining applicant's invention, differs patentably from the prior art, it is believed that this claim, as well as the dependent claims be found allowable.

The Examiner's attention is respectfully directed to the decision of the court decision in the case of *In re Bisley* (94 U.S.P.Q. 80, 86), in which the court ruled that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

In the case of *ex parte Chicago Rawhide Manufacturing Company* (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

Furthermore, in the case of *The Standard Oil Company vs. American Cyanamid Company* (227 U.S.P.Q. 293), the court ruled that the issue of obviousness is determined entirely with reference to a hypothetical person having ordinary skill in the art. It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventor's, as a class, according to the concepts underlying the constitution and the statutes that have created the patent system, possess something that sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under 35 U.S.C. 103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelation of references. A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive systematic research or by extraordinary insight; it makes no difference which.

In combining references as the Examiner has done, the Court decided in the case of *Uniroyal Inc. versus Rudkin-Wiley*

Corporation (5 U.S.P.Q.2d 1434) that when prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness of making the combination.

The preceding Court decision is reinforced by the case of *In re Dow Chemical Company* (5 U.S.P.Q.2d 1529), in which the Court ruled that most technological advance is the fruit of methodical persistent investigation, as is recognized in 35 U.S.C. §103. The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

In the case of *United Merchants and Manufacturers Incorporated versus Ladd* (139 U.S.P.Q. 199), the District Court ruled that although from simplicity of device and with advantage of hindsight, one might off-handedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the references discloses or suggests the concept which is the crux of the invention.

In *Ex parte Fleischmann* (157 U.S.P.Q. 155), the Patent Office Board of Appeals ruled that while it might be possible to select features from secondary references and mechanically combine them with primary reference to arrive at applicant's claim combination, there is no basis for making such combination disclosed or suggested in references; only applicant's specification suggests any reasons for combining references; under 35 U.S.C. 103, that does not constitute a bar.

Furthermore, in the case of *Panduit Corporation v. Burndy Corporation* (180 U.S.P.Q. 498), the District court ruled that

inquiry into patentability must be directed towards subject matter as a whole and not to elements of combination and their individual novelty; combination which results in a more facile, economical, or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by showing that elements are individually old.

Finally, in the case of Menge and Drissen (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

In view of the amendments to the claims, and in view of the preceding remarks, it is respectfully requested that the claims in the application be allowed and the case be passed to issue.

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